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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/538,792	03/30/2000	Vincenzo Scotto Di Carlo	GR 97 P 2659	7892

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Lerner and Greenberg PA
Post Office Box 2480
Hollywood, FL 33022-2480

EXAMINER

PHAN, JOSEPH T

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 11/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/538,792

Applicant(s)

DI CARLO ET AL.

Examiner

Joseph T Phan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Amendment Entry

1. It is noted that this application #09/538792, has not been abandoned per RCE, paper #14. Examiner has verified that applicant attempted to submit proper RCE prior to the 6-month deadline on 06/27/03 but was delayed because of improper fax transmittal. Entry of applicant's amendment, paper #12 filed 05/23/03 per proper RCE, paper #14 submitted 10/29/03 has been approved. Pending claims are below.

Response to Arguments

2. Regarding applicant's arguments, paper #12 page 6, filed 05/23/03, with respect to the 112 2nd paragraph rejection on claim 12 have been fully considered and are persuasive. Therefore, the 112 2nd paragraph rejection of claim 12 has been withdrawn.

Regarding applicant's arguments, paper #12, regarding the prior art of record, Picard, for claim 1, Applicant argues that Picard does not disclose selecting, by the subscriber, at least one terminal from a plurality of terminals of the message services. Examiner respectfully disagrees as Picard's system still reads on the newly amended claim 1 of allowing the subscriber to select at least one terminal from a plurality of terminals (*telephone handset, Personal computer, cellular phone, etc.*) of the message services(*voicemail, email, SMS, etc.*) [Picard col.3 lines 50-56 and col.4 lines 10-30]. Furthermore, Picard's system transmits a notification message for the subscriber in the one terminal selected for use by the subscriber and the system retrieves the message for the appropriate

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message service in which the notification message was present(Picard col.7 lines 20-29 and col.8 lines 42-54)

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-12 rejected under 35 U.S.C. 102(e) as being anticipated by Picard et al., Patent No. 6,233,318.

Regarding claim 1, Picard teaches a method of notifying a subscriber of a plurality of message services of a message, which comprises:
indicating, with each of a plurality of message services, to a common notification server a presence of a new message for a subscriber on the respective message service(col.3 lines 33-51) ;

selecting, by the subscriber, at least one terminal from a plurality of terminals of the message services (col.3 lines 49-56, col.4 lines 4-14, and col.11 lines 16-27);
and transmitting, with the notification server, to the least one terminal selected a notification indicating that a new message is present and in which message service the new message is present (col.2 lines 26-54 and col.11 lines 37-50).

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Regarding claim 2, Picard teaches the method according to claim 1, which comprises, if a message service indicates the presence of a new message, storing with the notification server the data originating from the message service, until the respective notification has been transmitted successfully(col.11 lines 28-36 and lines 49-59).

Regarding claim 3, Picard teaches the method according to claim 1, wherein the transmitting step comprises transmitting with the notification server the notification to all terminals of the subscriber(col.11 lines 17-27 and 37-42).

Regarding claim 4, Picard teaches the method according to claim 1, wherein the transmitting step comprises transmitting with the notification server the notification to at least one terminal selected by the subscriber from a plurality of terminals (col.4 lines 4-14 and col.11 lines 37-42).

Regarding claim 5, Picard teaches the method according to claim 4, wherein the subscriber selects the terminal by transmitting a control information item from the respective terminal to the notification server (col.4 lines 4-14 and col.11 lines 17-27)

Regarding claim 6, Picard teaches the method according to claim 1, which comprises transmitting with each message service a message header information item to the notification server when a new message is present, and transmitting the message header information with the notification server at least partially to the at least one terminal selected, at least partially, to output the message header information (col.6 lines 35-62, col.7 lines 29-40 and col.19 lines 1-25).

Regarding claim 7, Picard teaches the method according to claim 1, which comprises, in response to a request by the notification server, transmitting with each message service a message header information item to the notification server, and transmitting at least partially the message header information item with the notification server to the at least one terminal selected to output the message header information(col.6 lines 35-62, col.7 lines 29-40 and col.19 lines 1-25).

Regarding claim 8, Picard teaches the method according to claim 1, which comprises, in response to a subscriber request from any terminal, firstly performing an authorization check with the notification server and then transmitting the notifications present to the terminal [col.4 lines 4-30, col.6 lines 35-62; subscriber is understood to have to log in(authorization check) to the notification server to access his/her messages].

Regarding claim 9, Picard teaches the method according to claim 1, which comprises processing with the notification server the data originating from the message services for generating the notifications transmitted to the subscriber(col.3 lines 38-62).

Regarding claim 10, Picard teaches the method according to claim 9, wherein the processing step comprises selecting one or more processes from the group consisting filtering, ordering, and formatting the data (col.3 lines 38-62 and col.11 lines 51-59; the data is formatted for the subscriber).

Regarding claim 11, Picard teaches the method according to claim 1, wherein the transmitting step comprises transmitting the notifications by means

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of a signaling operation to the at least one terminal of the subscriber (col.11 lines 37-59; the notification alerts are signaling operations).

Regarding claim 12, Picard teaches the method according to claim 1, wherein the transmitting step comprises transmitting the notifications by means of a call set-up to the at least one terminal of the subscriber (col.4 lines 9-14 and col.11 lines 37-42; notification can be sent to telephones or cellular phones which is used for call set-up).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph T Phan whose telephone number is 703-305-3206. The examiner can normally be reached on M-TH 9:00-6:30, in every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 703-305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-9600.

JTP
November 14, 2003

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

